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UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte UWE BACHER

Appeal 2009-001102
Application 10/662,759
Technology Center 3700

Decided:¹ ²June 5, 2009

Before DEMETRA J. MILLS, LORA M. GREEN, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

² Oral Hearing in this case took place May 21, 2009.

STATEMENT OF CASE

This is an appeal under 35 U.S.C. § 134. The Examiner has rejected the claims for obviousness. We have jurisdiction under 35 U.S.C. § 6(b). The following claims are representative.

1. Medical instrument with a shaft, a handle mounted on the proximal end of the shaft, and a tool mounted on the distal end of the shaft and activated by the handle, where the handle and the tool are in active connection by means of at least one activation rod and the tool can be secured detachably by means of a tool shaft on the activation rod, for which purpose the tool shaft and the activation rod have protuberances and/or recesses, which can be joined in a form-locking connection, at least partially with corresponding recesses or protuberances of the other respective component wherein the recesses and protuberances corresponding to one another are configured in such a way that the tool and the activation rod can be brought into engagement with one another by means of a movement exclusively in one direction essentially perpendicular to the longitudinal axis of the activation rod, and the components coupled to one another are nonmoveably fixed relative to one another in all directions other than the one direction essentially perpendicular to the longitudinal axis of the activation rod.

4. Medical instrument according to claim 3, wherein the activation rod and the tool shaft are configured as essentially round in cross-section.

5. Medical instrument according to claim 4, wherein in the area of the distal end of the round activation rod at least on one side a tangential leveling is formed on the activation rod in such a way that the distal end of the activation rod further has a head area overhanging the leveling in radial direction and the proximal area of the tool shaft has an overlap for receiving the head area of the activation rod and a recess corresponding to the tangential leveling of the activation rod.

6. Medical instrument according to claim 5, wherein the tangential leveling of the activation rod is configured as a middle stud leveled from two opposite sides and the corresponding recess on the tool shaft is configured as a radial slit.

7. Medical instrument according to claim 6, wherein the activation rod and the tool can be coupled to one another by means of at least one stud running diagonally to the instrument longitudinal axis, where the stud on the one hand is stored in a hole bored in the activation rod or in the tool shaft and on the other hand engages in a corresponding recess in the tool shaft or in the activation rod.

8. Medical instrument according to claim 7, wherein, for the transmission of pulling or pushing forces in the coupling area, a spring element is placed between the activation rod and the tool.

Cited References

Strait	US 2,334,449	Nov. 16, 1943
LeMarie, III et al.	US 5,366,477	Nov. 22, 1994

Grounds of Rejection

1. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over LeMarie in view of Strait.

ISSUE

The Examiner argues that it “would have been obvious to one having an ordinary skill at the time of the invention was made to modify LeMarie by using the coupling as taught by Strait to provide and easy and quick connection and disconnection between the two members of the coupling.”
(Ans. 4.)

Appellant contends that the cited references do not disclose a tool shaft and activation rod secured by protuberances and/or recesses, which can be joined in a form-locking connection, at least partially with corresponding recesses or protuberances of the other respective component wherein “the recesses and protuberances corresponding to one another are configured in such a way that the tool and the activation rod can be brought into

engagement with one another by means of a movement exclusively in one direction essentially perpendicular to the longitudinal axis of the activation rod.” (App. Br. 5.)

The issue is: Does the combination of references disclose a tool shaft and the activation rod with protuberances and/or recesses, which can be joined in a form-locking connection, at least partially with corresponding recesses or protuberances of the other respective component wherein the recesses and protuberances corresponding to one another are configured in such a way that the tool and the activation rod can be brought into engagement with one another by means of a movement exclusively in one direction essentially perpendicular to the longitudinal axis of the activation rod, as claimed?

FINDINGS OF FACT

1. The Examiner finds:

LeMarie discloses a medical instrument with a shaft 18, a handle 14 mounted on the proximal end of the shaft 18, and a tool (50,52) mounted on the distal end of the shaft 18 and activated by the handle 14, wherein the handle 14 and the tool (50,52) are in active connection by means of at least activation rod (20) and the tool (50,52) can be secured detachably by means of a tool shaft on the activation rod (20), for which purposes the tool shaft (242) and the activation rod (248) have protuberances (246) which can be joined in a form-locking connection with corresponding recesses (244), wherein the recesses (244) and protuberances (246) corresponding to one another are configured in a such a way that the tool (50,52) and the activation rod (20) can be brought into engagement with one another by means of a movement exclusively in one

direction essentially perpendicular to the longitudinal axis of the activation rod (20). Note figures 1-3, 11a, 1b and 12.

(Ans. 3-4.)

2. According to the Examiner, “LeMarie discloses the invention substantially as claimed except the claimed coupling between the activation rod and the tool.” *Id.* at 4.)
3. “Strait discloses such coupling between male member 10 and female member 11.” *Id.* See also, Strait, Fig. 4.
4. The Examiner concludes that “[i]t would have been obvious to one having an ordinary skill at the time of the invention was made to modify LeMarie by using the coupling as taught by Strait to provide and easy and quick connection and disconnection between the two members of the coupling.” *Id.*
5. The Examiner finds as to claim 1 that “LeMarie teaches the tool (50,52) secured to the activation rod (20) in such a way that forces can be transmitted in the longitudinal direction of the activation rod (20) and/or torsion forces can be transmitted to the tool (50,52).” *Id.*
6. The Examiner argues that “a direction is the line or course on which something is moving (Merriam-Webster dictionary). Therefore, whether member 10 is moving downward or upward, it is still moving along the same line.” *Id.* at 5.

ANALYSIS

We select claim 1 as representative of the rejection of claims 1-4, as Appellant has not separately argued individual claims. Appellant contends that the cited references do not disclose a tool shaft and the activation rod

have protuberances and/or recesses, which can be joined in a form-locking connection, at least partially with corresponding recesses or protuberances of the other respective component wherein “the recesses and protuberances corresponding to one another are configured in such a way that the tool and the activation rod can be brought into engagement with one another by means of a movement exclusively in one direction essentially perpendicular to the longitudinal axis of the activation rod.” (App. Br. 5.)

According to Appellant,

Strait discloses a line shaft coupling for detachably attaching and adjoining ends of a pair of shaft sections together. A male member 10 of the coupling includes a projecting stem 12 with a pair of dove-tail lugs 13 upon each of two inset sides of the stem 12, while a female member 11 of the coupling includes a notch 16 having a pair of dove-tail sockets 17 in the side walls thereof arranged in matched relation with respect to the dove-tail lugs 13. The dove-tail lugs 13 have side walls that are perpendicular to a longitudinal axis of the male member 10, and the dove-tail sockets 17 have side walls that are perpendicular to a longitudinal axis of the female member 11. Thus, the male member 10 and the female member 11 can be brought into engagement with one another by means of a movement in two directions essentially perpendicular to the longitudinal axes of the members.

(App. Br. 6.)

More specifically, Appellant argues

with reference to Figure 4 of Strait, the male member 10 could be positioned “over” the female member 11, and then the two can be brought into engagement by moving the male member 10 downward (i.e., in a direction into the page), or the male member 10 could be positioned “under” the female member 11, and then the two can be brought into engagement by moving

the male member 10 upward (i.e., in a direction out of the page).

(App. Br. 7, Reply Br. 2.)

The Examiner responds, arguing that

a direction is the line or course on which something is moving (Merriam-Webster dictionary). Therefore, whether[, in Strait,] member 10 is moving downward or upward, it is still moving along the same line. The member is therefore, still moving in only one direction since the line/course has not changed.

Alternatively, the activation rod 6 and tool shaft 7 of the instant application are engaged when member 6 moves downward to engage member 7. Therefore the two members are brought into engagement in one direction perpendicular to the longitudinal axis of the activation rod 6. However, when flipped upside down, the activation rod 6 and tool shaft 7 are engaged when member 6 moves upward to engage member 7. This then qualifies as a second direction according to the appellant's argument. Therefore, based on the appellant's argument, the instantly claimed activation rod 6 and tool shaft 7 are not brought into engagement with one another by means of a movement in exclusively one direction.

(Ans. 5.)

We are not persuaded by Appellant's argument that Strait does not teach that the tool and activation rod can be brought into engagement with one another by means of a movement exclusively in one direction. In Strait, to engage the tool and the activation rod, "the male member 10 could be positioned 'over' the female member 11, and then the two can be brought into engagement by moving the male member 10 downward." (App. Br. 7.) Such a downward direction is "movement exclusively in one direction" as claimed. There is no disclosure in Strait that the male member 10 is required

to pass through female member 11 to engage female member 11. Thus male member 10 proceeds in exclusively one direction perpendicular to the longitudinal direction of the activation rod to engage female member 11.

CONCLUSION OF LAW

The combination of references disclose a tool shaft and the activation rod with protuberances and/or recesses, which can be joined in a form-locking connection, at least partially with corresponding recesses or protuberances of the other respective component wherein the recesses and protuberances corresponding to one another are configured in such a way that the tool and the activation rod can be brought into engagement with one another by means of a movement exclusively in one direction essentially perpendicular to the longitudinal axis of the activation rod, as claimed.

In view of the above, the obviousness rejection of claim 1-4 is affirmed.

Claims 5 and 8

Claim 5 recites an activation rod with tangential leveling and an overhanging head area on one end to connect with a corresponding tool shaft having an overlap for receiving the head area and a recess for receiving the tangential leveling of the activation rod.

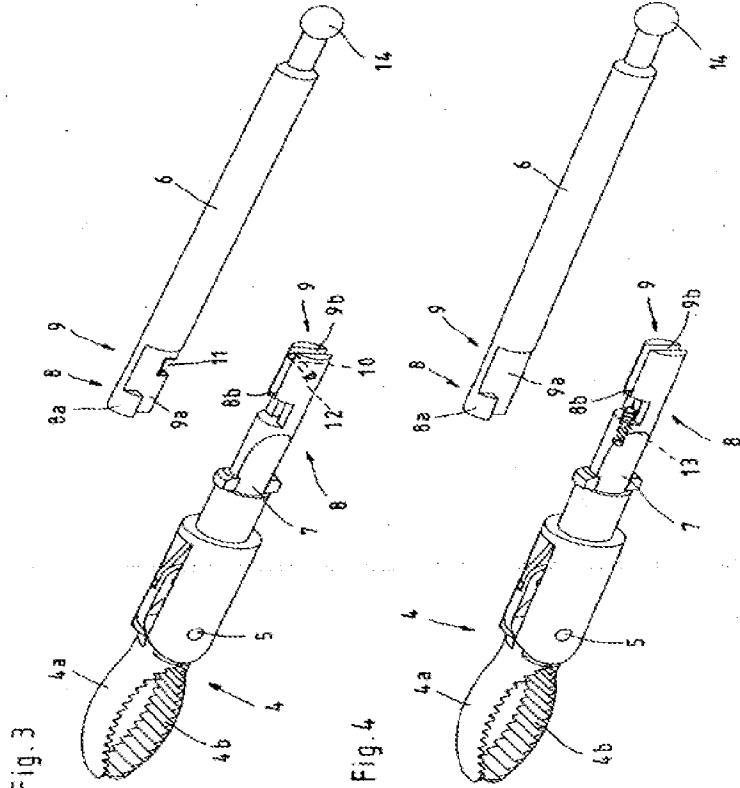
ADDITIONAL FINDINGS OF FACT

7. The Specification, page 6, paragraph 29 states:

In the embodiments illustrated in FIGS. 2a to 4, the recesses 9 on the activation rod 6 are formed by tangential levelings which are configured on two opposite sides on the

activation rod 6 in such a way that the activation rod in the area of this leveling consists only of a narrow middle stud 9a.

Figures 3 and 4 of the instant disclosure are reproduced below:



Figures 3 and 4 show recesses 9 corresponding to the tangential leveling of the activation rod (6). (Specification, 12.)

ANALYSIS

According to Appellant, the coupling method disclosed by Strait must replace the coupling method disclosed in Figures 11a - 11b of LeMarie. (App. Br. 10.) “Using the coupling method of Strait and the coupling method of LeMarie simultaneously is neither practical nor possible. For this reason, rejecting claim 5 with reference to this portion of LeMarie is inappropriate because the coupling disclosed in Strait could not be used in

conjunction with the coupling disclosed in Figures 11a-11b of LeMarie.” (App. Br. 10.) The Examiner responds that Appellant does not define “tangential leveling” and does not demonstrate where the leveling is tangential to the activation rod. (Ans. 6.)

We find the Specification depicts a tangential leveling in Figs 3 and 4. The Examiner has not indicated how the coupling of Strait can be used in conjunction with the coupling of LeMarie, rather, the Examiner substitutes the coupling of Strait for the coupling of LeMarie. (Ans. 4.) We find the argument of Appellant to be persuasive and the obviousness rejection of claim 5 is reversed.

Claim 8 recites the use of a spring element placed between the activation rod and a medical tool for the transmission of pulling or pushing forces in the coupling area. Appellant argues that claim 8 is patentable on the additional ground that use of a spring in the combination of LeMarie and Strait would not be practicable or possible. (App. Br. 11.) “The use of a spring as disclosed by LeMarie with the coupling method of Strait would not be desireable. As seen and described in Figures 1 and 3 and page 1 of Strait, a threaded collar 20 is used to secure male member 10 and female member 11 together. The spring of LeMarie would have no effect on the coupling, since the male and female members are fixed relative to one another by the threaded collar 20.” (App. Br. 11.)

We do not find that the Examiner has explained how the spring of LeMarie can modify the coupling of Strait. We find the argument of Appellant to be persuasive and the obviousness rejection of claim 8 is reversed.

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SUMMARY

The obviousness rejection of claims 1-4 is affirmed. The obviousness rejection of claims 5-8 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

cdc

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